

Notice of Allowability

Application No.

10/648,180

Examiner

William K Cheung

Applicant(s)

COTTMAN ET AL.

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to _____.
2. ☒ The allowed claim(s) is/are 1-15, 20.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Alvin T. Rockhill (Registration No. 30,417) on September 2, 2004.

2. Cancel claims 16-19.

Allowances

3. Claims 1-15, 20 are allowed.
4. The following is an examiner's statement of reasons for allowance:

Art Unit: 1713

As of the date of this office action, the examiner has not located or identified any reference that can be used singularly or in combination with another reference including the closest prior art of Feeney et al. (US 4,060,503) in view of Oberkirch et al. (US 3,719,652) to render the present invention anticipated or obvious to one of ordinary skill in the art.

*The invention of claims 1-15, 20 relates to a **process for synthesizing a hydrogenated resin** having characteristics that make it particularly useful as a tackifier resin having low odor and low color characteristics, said **process comprising** the steps of (1) **polymerization of an unsaturated hydrocarbon monomer mixture** in the presence of **aluminum halide and an allylic halide** to produce an unsaturated resin, wherein the unsaturated hydrocarbon monomer mixture is composed of unsaturated hydrocarbon monomers containing from about **4 to about 18 carbon atoms**, and wherein said process is conducted in the absence of tantalum compounds; and (2) **hydrogenating the unsaturated resin** in the presence of a **palladium on alumina** catalyst system at a temperature which is within the range of about **120°C to about 240°C** to produce the **hydrogenated resin**.*

The closest prior art Feeney et al. (col. 1, line 52 to col. 2, line 16) disclose a process for synthesizing a styrene-isoprene-styrene elastomeric block copolymer from a mixture of styrene and isoprene in the presence of aluminum halide in the presence of

Art Unit: 1713

aluminum halide conducted in the absence of tantalum compounds. Further, Feeney et al. (col. 2, line 6-16; col. 3, line 39-53) disclose that the mixture further comprises 2-methyl-2-butene, piperylene, and cyclopentene. However, Feeney et al. are silent on using an allylic halide in the disclosed process.

Oberkirch et al. (col. 3, line 35-46) disclose a resin preparation process that involves using a tantalum/allyl halide catalyst system containing a tantalum compound. Since Oberkirch et al. teach a process that employs tantalum compounds and allyl halide compounds together in a single catalyst package, it would not be apparent to one of ordinary skill in art to use the allyl chloride teachings of Oberkirch et al. in Feeney et al. to obtain the present invention because removing the tantalum compounds in Oberkirch et al. would have destroyed the teachings of Oberkirch et al. In view of lack of motivation to combine the teachings of the closest prior art to Feeney et al. and Oberkirch et al., the invention of claims 1-15, 20 is allowed.

In light of the above discussion, it is evident as to why the present claims are patentable over the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, and to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung
Primary Patent Examiner

September 2, 2004

**WILLIAM K. CHEUNG
PRIMARY EXAMINER**